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C. REMARKS

1. Summary of the Claims

Claims 1-20 are currently pending in the application. Claims 1, 8, and 15 are independent claims. Claims 1, 3, 7, 8, 10, 13, 14, 15, 17, and 20 have been amended. Claims 2, 9, and 16 have been cancelled. No claims have been added. No new matter has been added. Reconsideration of the claims is respectfully requested.

2. Examiner Interview

Applicant notes with appreciation the telephonic interview conducted between Applicant's patent agent, Scott Schmok, and the Examiner on September 9, 2004. During the telephonic interview, the Examiner and Applicant's patent agent discussed the 102 reference (Zehr, et al., U.S. Publication No. 2001/0025274). In particular, Applicant's patent agent highlighted the differences between the Zehr reference and limitations included in Applicant's claim 2. Applicant's patent agent emphasized that Applicant includes advertisements in a requesting user's printed document based upon user attributes in exchange for reduced or free printing services, such as printing at a hotel. In contrast, Applicant's patent agent pointed out that Zehr teaches the insertion of advertisements based upon recipient attributes, such as with sending greeting cards.

Applicant's patent agent suggested amending claims 1, 8, and 14 to include the limitations of claims 2, 9, and 15, respectively, in order to read over Zehr. The Examiner agreed that the proposed amendment may read over Zehr, but the

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Examiner wished to review the Zehr reference in more detail before agreeing.

Applicant has made such amendments to independent claims 1, 8, and 15. While no agreement was reached regarding the claims, Applicant respectfully submits that, as explained in further detail below, the amendments made to claims 1, 8, and 15, place these claims and their respective dependent claims in condition for allowance.

3. Drawings

Applicant notes that the Examiner did not indicate whether the formal drawings, filed with Applicant's application, are accepted by the Examiner. Applicant respectfully requests that the Examiner indicate whether the formal drawings are accepted in the next office communication.

4. Claim Rejections 35 U.S.C. § 102

Claims 1-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Zehr et al. (U.S. Pub. 2001/0025274, hereinafter "Zehr"). Applicant respectfully traverses these rejections.

Each of the limitations included in the independent claims was rejected under 35 U.S.C. § 102(e) as being anticipated by Zehr. A claim is anticipated under § 102 only if each and every element of the claim is found, either expressly or inherently, in a single prior art reference. MPEP § 2131 states, in part:

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TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). >"When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02.< "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01.

As described in further detail below, Zehr falls far short of teaching each and every element of Applicant's independent claims. Comparing Applicant's claim limitations with the sections of Zehr cited in the Office Action make this amply clear.

The independent claims are directed to "printing documents" with limitations comprising:

- receiving one or more images from one or more image providers;
- receiving one or more user attributes from a requestor, the user attributes corresponding to the requestor;

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- receiving a print request from the requestor, the print request including an electronic document;
- combining at least one of the images with the electronic document forming an electronic image document, wherein the combining includes selecting the images based on the user attributes; and
- printing the electronic imaged document.

As discussed with the Examiner, Applicant has amended claim 1 to incorporate the limitations of claim 2, which include "receiving one or more user attributes from the requestor" and "selecting the images based on the user attributes." Applicant's invention allows a requestor, such as a person at a hotel, to receive free or reduced printing services in exchange for the requestor's printed documents to include advertisements that are tailored towards the requestor. For example, when a person is on business travel and requests to print a document using a remote printer (i.e., a hotel, airport, copy service printer, etc.), the requesting person is asked for information about his occupation and other personal attributes. In this example, the information is used to select advertising that is appropriate to the requesting person. The person requests to print out electronic documents and the selected advertisements are included in the printout.

In contrast, Zehr's invention provides reduced printing costs to a person that wishes to send printed material to recipients (i.e. greeting cards), whereby the printed material includes advertisements that are tailored towards the recipients. Zehr, on page 4 paragraph 0041, states that "An advertiser can place or change orders corresponding to ... the price they are willing to pay for advertising directly to a

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particular mail recipient" (emphasis added). In addition, paragraph 0041 provides an example and states "an advertiser for a luxury car company can choose to advertise only to those individuals living in ZIP codes wherein the average home price is over \$300,000." Therefore, it can clearly be seen that Zehr teaches advertisement inclusion based upon mail recipient attributes, and not user attributes that correspond to a requestor as claimed by Applicant.

The Office Action contends, however, that Zehr teaches receiving one or more user attributes from a requestor, wherein the combining includes selecting the images based on the user attributes. However, upon closer inspection, Zehr does not teach selecting images based upon the user attributes as suggested by the Office Action. Rather, the Office Action's reference in Zehr (paragraph 0067) refers to Zehr's Figure 10, and states that:

"a user need only select a previously stored address group name in the "To" line of the message of the end user interface 106 to send the message to a number of recipients of the group...such as..."Patients.""

Zehr's Figure 10 "illustrates an address table suitable for sending a message to a number of recipients included within a group...[and includes]...the demographics information associated with the recipients within the group" (page 7, paragraph 0066, emphasis added). The Office Action reference cites demographic information associated with the recipients, and not user attributes associated with a requestor as claimed by Applicant.

Therefore, since Zehr does not teach or suggest all the limitations included in Applicants' claim 1 as amended,

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amended claim 1 is not anticipated by Zehr and, accordingly, amended claim 1 is allowable over Zehr. Claim 8 as amended is an information handling system claim including the same limitations of amended claim 1 and, therefore, is allowable for the same reason as amended claim 1. Claim 15 as amended is a computer program product claim including the same limitations of amended claim 1 and, therefore, is allowable for the same reason as amended claim 1.

Notwithstanding the fact that claim 5 is dependent upon amended claim 1 and therefore allowable for the same reasons as amended claim 1, claim 5 adds the limitations to amended claim 1 of:

- determining a document type of the electronic document;
- matching the document type with one or more image document types provided by the image providers; and
- selecting one or more images based on the matching.

Applicant's claim "determining a document type," which *"is a document content type that corresponds to the type of document being printed based upon keywords that are detected in the user's document or other attributes of the document"* (page 9, lines 11-14). Applicant uses the determined document type in order to identify appropriate advertisements. For example, if a keyword "vacation" was detected, the determined document type may be "leisure" and, as such, advertisements corresponding to rental cars and vacation packages may be inserted into a requestor's printed document.

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The Office Action contends that Zehr teaches all the limitations included in Applicant's claim 5, and uses paragraph 0028 in Zehr as its basis for rejecting claim 5. However, upon closer inspection, Zehr does not teach or suggest "determining a document type" as claimed by Applicants. Rather, Zehr's paragraph 0028 states that:

"a user composes an e-mail message and addresses the e-mail to a recipient at a particular domain...the recipient's physical address and other demographic statistics are looked up in a user database 32. The particulars of this type of physical address look-up system are not disclosed here as such a system can be constructed with reference to U.S. Patent No. 5,805,810." (emphasis added)

In other words, Zehr teaches looking up a recipient's information in a database, which is completely different than "determining a document type" as claimed by Applicant. Therefore, since Zehr does not teach or suggest all the limitations included in Applicants' claim 5, claim 5 is not anticipated by Zehr and, accordingly, claim 5 is allowable over Zehr. Claim 12 is an information handling system claim including the same limitations of claim 5 and, therefore, is allowable for the same reason as claim 5. Claim 19 is a computer program product claim including the same limitations of claim 5 and, therefore, is allowable for the same reason as claim 5.

Notwithstanding the fact that claim 7 is dependent upon amended claim 1 and therefore allowable for the same reasons as amended claim 1, claim 7 adds the limitations to amended claim 1 of:

- registering the requestor, the registering including:

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- collecting one or more of the user attributes from the requestor;
- providing the requestor with a user authentication mechanism; and
- determining one or more images based on the user attributes, wherein the images include at least one advertisement.

Applicant claims "registering the requestor" whereby the requestor is one that initiates print requests. The Office Action contends that Zehr teaches all the limitations included in Applicant's claim 7, and uses paragraphs 0039 and 0040 in Zehr as a basis for rejecting claim 7. However, upon closer inspection, Zehr does not teach or suggest "registering the requestor" and "collecting one or more user attributes" as claimed by Applicant. Rather, paragraphs 0039 and 0040 state that:

"The advertisement image database 68 stores the graphical representations of advertisements and can be accessed and updated with new images by advertiser users with the proper permissions... An advertiser user can place or change orders corresponding to the preferred target market...[such as] advertis[ing] only to those individuals living in ZIP codes wherein the average home price is over \$300,000" (emphasis added)

In other words, Zehr teaches registering advertisers and collecting information corresponding to the advertisers' target market, which is completely different than registering a requestor that wishes to print a document as claimed by Applicant.

Therefore, since Zehr does not teach or suggest all the limitations included in Applicant's claim 7, claim 7 is not anticipated by Zehr and, accordingly, claim 7 is allowable over Zehr. Claim 14 is an information handling system claim

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including the same limitations of claim 7 and, therefore, is allowable for the same reason as claim 7. Claim 20 is a computer program product claim including the same limitations of claim 7 and, therefore, is allowable for the same reason as claim 7.

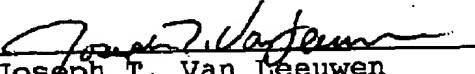
Each of the remaining claims 3, 4, 6, 10, 11, 13, 17, and 18 each depend, directly or indirectly, on one of the allowable independent claims 1, 8, and 15. Therefore, claims 3, 4, 6, 10, 11, 13, 17, and 18 are also allowable for at least the same reasons that their respective independent claims are allowable.

CONCLUSION

As a result of the foregoing, it is asserted by Applicants that the amended claims in the Application are in condition for allowance, and Applicants respectfully request an early allowance of such claims.

Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

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